

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed January 3, 2008. At the time of the Office Action, Claims 1-47 were pending in this Application. Claims 1-26 and 46 were previously withdrawn due to an election/restriction requirement. Claims 27-45 and 47 were rejected. Claims 27, 45, and 47 have been amended to further define the claimed invention. Applicants respectfully request reconsideration in light of the remarks below and favorable action in this case.

Information Disclosure Statement

The references submitted by Applicants are believed to be material to the patentability of the present claims, and have been presented in accordance with Rule 56 and in order to comply with Applicants' duty of candor and good faith.

Specification Objections

The disclosure was objected to by the Examiner because there is no brief drawing description for FIGS 10I and 13E. Applicants have submitted above amendments to paragraphs [0045] and [0049] to correct clerical errors.

Rejections under 35 U.S.C. § 102

Claims 27, 29, 30, 32-45 and 47 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,997,925 issued to Maguire et al. ("Maguire"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the

Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With regard to claim 27, the Examiner contends that Maguire discloses an electrosurgical device comprising a shaft, a return electrode, and at least one active electrode comprising an arm portion being radially spaced from the return electrode. More specifically, Maguire teaches a circumferential ablation member having a plurality of splines (i.e., active electrodes) spaced around a longitudinal axis and being adjustable between a first condition and a second condition. However, Maguire does not describe that the active electrodes are fixedly spaced from the return electrode, as is now recited by amended claim 27. Therefore, Maguire does not disclose all the elements of claim 27 as amended, and cannot anticipate amended claim 27. Applicants respectfully submit that claim 27 as amended is in condition for allowance, and request withdrawal of the rejection.

Claims 29, 30, and 32-44 depend directly or indirectly from amended claim 27. Applicants repeat and hereby incorporate the remarks made above regarding amended claim 27. For at least these reasons, Applicants respectfully submit that claims 29, 30, and 32-44 are also allowable over Maguire, and request withdrawal of the rejection.

With regard to claims 45 and 47, Applicants repeat and hereby incorporate the remarks made above regarding amended claim 27. Specifically, Maguire does not disclose active electrodes that are fixedly spaced from the return electrode, as is not recited by amended claims 45 and 47. Therefore, Maguire does not disclose all the elements of claims 45 and 47 as amended, and cannot anticipate amended claims 45 and 47. Applicants respectfully submit that claims 45 and 47 as amended is in condition for allowance, and request withdrawal of the rejection.

Rejections under 35 U.S.C. §103

Claims 28 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Maguire. Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580

(C.C.P.A. 1974). Claims 28 and 31 depend directly or indirectly from amended claim 27. Applicants repeat and hereby incorporate the remarks made above regarding amended claim 27. For at least these reasons, Applicants respectfully submit that claims 28 and 31 are also allowable over Maguire, and request withdrawal of the rejection.

Information Disclosure Statement

Applicants enclose an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner's review and consideration.


CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$1050 for the Three-Month Extension of Time and \$180 for the IDS and any additional fees necessary or credit any overpayments to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted
Attorney for Applicants,



Matthew Scheele
Reg. No. 59,847

Date: 7/1/08

SEND CORRESPONDENCE TO:

ARTHROCARE CORPORATION

CUSTOMER NO. **21394**

512.358.5925

512.391.3901 (fax)

Enclosure: 1) Information Disclosure Statement and PTO Form 1449, with copies of the references.